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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/515,928	02/29/2000	Bert Whitmore Elliott	24673A	1357

7590 04/25/2006

OWENS CORNING
2790 COLUMBUS ROAD
BUILDING 54
GRANVILLE, OH 43023

EXAMINER

CANFIELD, ROBERT

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 04/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/515,928

Applicant(s)

ELLIOTT, BERT WHITMORE

Examiner

Robert J. Canfield

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17 and 46-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17 and 46-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3635

1. This Office action is in response to the amendment filed 02/13/06. Claims 17 and 46-64 are pending. Claims 1-16 and 18-45 have been canceled.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 46-54 and 56-64 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to describe or discuss the specific percentiles now claimed. This is a new matter rejection.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 17, 46, 48, 49, 51, 52, 54-56, 58, 59, 61, 62 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,014,847 to Phillips in view of U.S. Patent 1,843,370 to Overbury.

Phillips provides laminated shingles having an overlay member 12 provided with generally rectangular tabs 20a-20c of different sizes, which are separated by cutouts 22a-22c. The figures show three tabs. The widths of the cutouts are

considered sufficiently narrow to simulate slate tiles. Further, the reference states that the widths of the tabs may be varied depending on the desired appearance, which would suggest that the tabs could have been made wider which would result in narrower cutouts. The overlay 12 is laminated to an underlay 14 which is provided a layer of granules substantially darker than that those of the overlay. The lower edge of overlay member is shown generally co-linear with the lower edge of the underlay member.

Phillips fails to teach that the color blends of the tabs of the overlay members are different from another with one of the color blends occurring more frequently than any of the other color blends.

Phillips also fails to specify gray as the predominant color blend.

Overbury teaches that at the time of the invention it was known to make the tabs of a shingle of different colors and to confine each color to the portion which corresponds to one tab (column 2, lines 20+) for aesthetic purposes. Overbury further provides that if desired two or more tabs may be given the same color (page 2, line 96). Figure 6 of Overbury shows multiple tabs of different colors with one of the tabs (left most) being predominant.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the tabs of the overlay of Phillips could have been provided with color blends different from one another with one color blend occurring more frequently, as taught by Overbury, to achieve a desired artistic effect. Phillips teaches at the top of column 4, that it should be understood that different color

arrangements could be used. The choice of gray as the predominant color blend is nothing other than a choice of design which would have been obvious at the time of the invention to one having ordinary skill in the art. Gray is a common shingle color. Further, Overbury suggests variety of colors and calls for crushed slate (generally recognized as gray in color) as the granular material. The particular percentages recited in the claims would have been nothing other than obvious choices of design at the time of the invention to one having ordinary skill in the art as Overbury teaches great possibilities of variance for artistic effects. Further, applicant's specification fails to provide any problem in the art solved by the particular percentiles claimed and in fact never even mentions the percentiles now claimed.

6. Claims 17, 46, 47, 49, 50, 52, 53, 55-57, 59, 60, 62, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,195, 290 to Hulett in view of U.S. Patent 1,843,370 to Overbury.

Hulett provides laminated shingles having overlay members provided with a plurality of generally rectangle tabs (figures 5, 6, and 8) separated by cutouts and underlay members provided with darker granules for a more pleasing appearance (column 4, lines 63+). The figures show embodiments including at least four tabs.

Hulett fails to teach that the color blends of the tabs of the overlay members are different from another with one of the color blends occurring more frequently than any of the other color blends.

Hulett also fails to specify gray as the predominant color blend.

Overbury teaches that at the time of the invention it was known to make the tabs of a shingle of different colors and to confine each color to the portion which corresponds to one tab (column 2, lines 20+) for aesthetic purposes. Overbury further provides that if desired two or more tabs may be given the same color (page 2, line 96). Figure 6 of Overbury shows multiple tabs of different colors with one of the tabs (left most) being predominant.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the tabs of the overlay of Hulett could have been provided with color blends different from one another with one color blend occurring more frequently, as taught by Overbury, to achieve a desired artistic effect.

The choice of gray as the predominantly color blend is nothing other than a choice of design which would have been obvious at the time of the invention to one having ordinary skill in the art. Gray is a common shingle color. Further, Overbury suggests variety of colors and calls for crushed slate (generally recognized as gray in color) as the granular material. The particular percentages recited in the claims would have been nothing other than obvious choices of design at the time of the invention to one having ordinary skill in the art as Overbury teaches great possibilities of variance for artistic effects. Further,

Art Unit: 3635

applicant's specification fails to provide any problem in the art solved by the particular percentiles claimed and in fact never even mentions the percentiles now claimed.

7. Claims 17, 46, 47, 49, 50, 52, 53, 55-57, 59, 60, 62, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,939,169 to Bondoc et al. in view of U.S. Patent 1,843,370 to Overbury.

Bondoc laminated shingles having overlay members provided with a plurality of generally rectangle tabs 16 and separated by narrow cutouts, which have beveled edges in the embodiment of Figures 4A-4C, and underlay members 11, 15 provided with darker granules.

Bondoc fails to teach that the color blends of the tabs of the overlay members are different from another with one of the color blends occurring more frequently than any of the other color blends.

Bondoc also fails to specify gray as the predominant color blend.

Overbury teaches that at the time of the invention it was known to make the tabs of a shingle of different colors and to confine each color to the portion which corresponds to one tab (column 2, lines 20+) for aesthetic purposes. Overbury further provides that if desired two or more tabs may be given the same color (page 2, line 96). Figure 6 of Overbury shows multiple tabs of different colors with one of the tabs (left most) being predominant.

Art Unit: 3635

It would have been obvious at the time of the invention to one having ordinary skill in the art that the tabs of the overlay of Bondoc could have been provided with color blends different from one another with one color blend occurring more frequently, as taught by Overbury, to achieve a desired artistic effect.

The choice of gray as the predominantly color blend is nothing other than a choice of design which would have been obvious at the time of the invention to one having ordinary skill in the art. Gray is a common shingle color. Further, Overbury suggests variety of colors and calls for crushed slate (generally recognized as gray in color) as the granular material. The particular percentages recited in the claims would have been nothing other than obvious choices of design at the time of the invention to one having ordinary skill in the art as Overbury teaches great possibilities of variance for artistic effects. Further, applicant's specification fails to provide any problem in the art solved by the particular percentiles claimed and in fact never even mentions the percentiles now claimed.

8. Applicant's arguments filed 02/13/06 have been fully considered but they are not persuasive.

Applicant's argument that the teachings of Phillips, Hulett and/or Bondoc cannot reasonably be combined with the teaching of Overbury because the former are related to laminated shingles whereas the later is related to a single layer shingle is not found persuasive. In response to applicant's arguments against the references individually,

Art Unit: 3635

one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Phillips, Hulett and Bondoc have been used to teach the claimed structure of an laminated shingle having tabs formed in an overlay member and Overbury has been used to teach that it was known at the time of the invention that tabs of shingles in general could be colored different as a choice of design for artistic effect.

Applicant's argument that none of the references teach one of the color blends occurring more frequently or predominantly than the others is not found persuasive. Overbury clearly shows in at least Figure 6 one color blend occurring more predominantly than others. Also, Overbury recites at page 2 lines 94-96 that if desired two or more tabs may be given the same color.

Applicant's argument that none of the references teaches gray as the predominant color so as to simulate a natural slate roof is not found persuasive. Overbury teaches that any or a variety of colors may be chosen and even discusses crush slate as the granular material used on the tabs. Each of which would have suggested the use of the color gray to one having ordinary skill in the art at the time of the invention. To have made gray the predominant color would have been obvious if one is attempting to simulate slate as Overbury is.

The previously submitted declaration has already been addressed as not persuasive.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

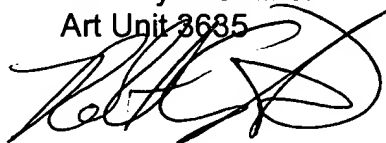
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Canfield whose telephone number is 571-272-6840. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert J Canfield
Primary Examiner
Art Unit 3635

A handwritten signature in black ink, appearing to read 'R. Canfield', is written over the printed name and title of the examiner.

04/21/06